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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/179,188	10/27/1998	TOSHINARI SAKURAI	KAS-125	5396
24956	7590	10/14/2004	EXAMINER	
MATTINGLY, STANGER & MALUR, P.C. 1800 DIAGONAL ROAD SUITE 370 ALEXANDRIA, VA 22314			NAFF, DAVID M	
			ART UNIT	PAPER NUMBER
			1651	
DATE MAILED: 10/14/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/179,188

Applicant(s)

SAKURAI ET AL.

Examiner

David M. Naff

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1651

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20,21,24,29,33-36 and 53-64 is/are pending in the application.
- 4a) Of the above claim(s) 60-64 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 20,21,24,29 and 33-36 is/are allowed.
- 6) ☒ Claim(s) 53-59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

In a response of 8/6/04, applicants elected Group I claims 20, 21, 24, 29, 33-36 and 53-59 without traverse.

Claims 60-64 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 8/6/04.

Claims 20, 21, 24, 29, 33-36 and 53-59 are examined on the merits

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112

Claims 53-59 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification fails to disclose that the invention was to be a method of washing a solid phase as required by claims 53-59. The specification discloses only an invention of recovering nucleic acids by a method as required by claim 20. There is no description in the specification of a method of washing as in claims 53-59 without steps that result in recovering nucleic acids from a material as in claim 20. The concept of an invention as required by claims 53-59 was not in the specification when originally filed.

Claim Rejections - 35 USC § 112

Claims 53-59 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for recovery of nucleic acids by a process as required by claim 20, does not
5 reasonably provide enablement for washing as in claims 53-59 without steps that result in recovery of nucleic acids from a material. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

10 The specification fails to describe enabling conditions for a process as required by claims 53-59 without steps of recovering nucleic acids as in claim 20. If nucleic acids are not recovered with steps as in claim 20, washing as in claim 53-59 will serve no function and purpose. The claims must be commensurate in scope with the
15 specification and provide results that are disclosed in the specification as being an objective of the invention.

Claim Rejections - 35 USC § 112

Claims 53-59 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and
20 distinctly claim the subject matter which applicant regards as the invention.

Claims 53-55 and 57-59 are unclear as to how using an accelerator substance as required in the preamble of claim 53 results in nucleic acids being bound to a solid phase. The relationship between the use
25 of the accelerator substance and obtaining bound nucleic acids is

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unclear. It is suggested that the steps of claim 56 for binding the nucleic acids to the solid phase be put in claim 53.

Claims 53-59 are confusing and unclear as to the function of washing as required. The specification does not describe washing in a process that does not involve recovery of nucleic acids as in claim 20. If nucleic acids are not recovered as in claim 20, washing as in claims 53-59 would not appear have any function.

Conclusion

Claims 20, 21, 24, 29 and 33-36 are allowed.

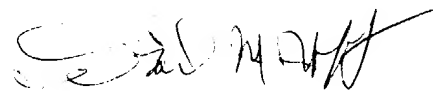
10 Claims 53-59 are free of the prior art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David M. Naff whose telephone number is 571-272-0920. The examiner can normally be reached on Monday-Friday 9:30-6:00.

15 If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Wityshyn can be reached on 571-272-0926. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



David M. Naff
Primary Examiner
Art Unit 1651

DMN
10/8/04